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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,767	01/17/2002	Gopal Thinakaran	ARCD:364US/MBW	5574

7590 09/29/2004  
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EXAMINER

LOCKARD, JON MCCLELLAND

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/051,767	<b>Applicant(s)</b> THINAKARAN, GOPAL	
	<b>Examiner</b> Jon M Lockard	<b>Art Unit</b> 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 13-51, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of presenilin 1 (PS1) protein, classification dependent upon compound structure.
- II. Claims 1-5, 7, and 13-51, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of presenilin 2 (PS2) protein, classification dependent upon compound structure.
- III. Claims 1-4, 13-36, and 38-42, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of an amyloid precursor protein and amyloid precursor protein derivatives, classification dependent upon compound structure.
- IV. Claims 1-2, 8-11, 13-23, and 34, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of a nicotinic acetylcholine receptor protein, classification dependent upon compound structure.
- V. Claims 1-2, 8-11, and 13-34, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of a GABA receptor protein, classification dependent upon compound structure.

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- VI. Claims 1-2, 8-11, and 13-34, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of a glycine receptor protein, classification dependent upon compound structure.
- VII. Claims 1-2, 8-10, and 12-34, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of a voltage-gated sodium channel protein, classification dependent upon compound structure.
- VIII. Claims 1-2, 8-10, and 12-34, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of a voltage-gated potassium channel protein, classification dependent upon compound structure.
- IX. Claims 1-2, 8-10, and 12-34, in so far as they are drawn to methods of identifying candidate substances that change the levels of accumulation of a voltage-gated calcium channel protein, classification dependent upon compound structure.

The inventions are distinct, each from the other because of the following reasons:

The various methods of Inventions I-IX are drawn to patentably distinct methods. Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for Inventions that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: The methods of Inventions I-IX are separate and distinct, each one from the other, as they utilize different starting materials, method steps, and require different outcomes and non-coextensive searches.

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Therefore, a search and examination of all the methods of Inventions I-IX in one patent application would result in an undue burden, since the searches for the Inventions' methods are not co-extensive.

*Election of Species*

**In addition to the above Restriction requirement, a further election of species is required as follows:**

If applicant elects any one of Inventions I-IX:

This application contains claims directed to the following patentably distinct species of the claimed invention: Claims 26-34 and 38-51 encompass several marker gene products: fluorescent gene product, yellow fluorescent protein, green fluorescent protein, blue fluorescent protein, red fluorescent protein, antibiotic resistant gene product, bleomycin resistance gene product, zeocin resistance gene product, zorbamycin resistance gene product, victomycin resistance gene product, platomycin resistance gene product, tallysomycin resistance gene product, SF 1771 resistance gene product, SF 1961 resistance gene product, and a YA 56 resistance gene product. Applicants are required to designate a single, ultimate species to be searched.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of marker gene products for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-25 and 35-37 are generic with regards to the marker gene product.

Furthermore, if applicant elects any one of Inventions I-IX:

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This application contains claims directed to the following patentably distinct species of the claimed invention: Claims 15-22 encompass several candidate substances: chemical compounds, protein, protein candidate substances, pharmacological compounds, and nucleic acids. Applicants are required to designate a single, ultimate species to be searched.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of candidate substances for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-14, 18, and 23-51 are generic with regards to the candidate substance.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jon M. Lockard, Ph.D.** whose telephone number is **(571) 272-2717**. The examiner can normally be reached on Monday through Friday, 8:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Brenda Brumback, Ph.D.** can be reached on **(571) 272-0961**.

The fax number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

JML

September 16, 2004

  
**BRENDA BRUMBACK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**